



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Hauptman Kanesaka Berner Patent Agents, LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

FILED
FROM DIRECTORS OFFICE

NOV 08 2006

TECHNOLOGY CENTER 3600

In re Application of:
Masakazu Sueda
Appl. No. 10/804,070
Filed: July 28, 2003
For: Metal Gasket

:PETITION FROM
:REQUIREMENT OF
:RESTRICTION
:UNDER 37 CFR 1.144

This is a decision on Applicant's Petition under 37 CFR 1.144 filed on May 24, 2006.
The delay in treating this petition is sincerely regretted.

The Petition is **GRANTED-IN-PART** to the extent indicated below.

Petitioner has requested that the election by original presentation made by the Examiner on February 14, 2006 be withdrawn, the Office action of May 2, 2006 be vacated, and the claims presented in the amendment filed on October 31, 2005 be examined.

Petitioner filed a response to a Rejection on October 31, 2005. In response to the amendment of October 31, 2005 the Examiner issued an Advisory Action. The Petitioner then submitted a Request for Continued Examination. A notice of non-responsive amendment was then issued due to withdrawal of all the pending claims by election by original presentation.

Petitioner states that originally presented claims 1-13 were directed to the Figures in the following manner: claims 1 and 2 were generic, claims 3 and 5 were directed to Figs. 7-11, claim 4 was directed to Figs. 7 and 8, claims 6 and 13 were explained in the specification, claims 7-9 were directed to Figs. 1-6, claim 10 was directed to Figs. 1, 2 and 5, claim 11 was directed to Figs. 3 and 4, and claim 12 was directed to Figs. 5 and 6. All the claims were examined in an Office Action mailed on April 19, 2005.

The Petitioner filed an amendment on June 30, 2005 in response to the Office Action of April 19, 2005. Petitioner states that the claims presented in the June 30, 2005 amendment were directed to the Figures as follows: claims 1 and 2 were directed to Figs. 1-6, claims 3-5, which should have depended from claim 16, were directed to Figs. 7-11, claim 6 was explained in the specification; claim 7 was canceled; claims 8-10 were directed to Figs. 1-6; claim 11 was directed to Figs. 3 and 4; claim 12 was

directed to Figs. 5 and 6; claim 13 was explained in the specification; claims 14 and 15 were directed to Figs. 1 and 2; claim 16 was directed to Figs. 7-11; claim 17 was directed to Figs. 9 and 10; and, claim 18 was directed to Fig. 11. All claims were examined in an Office Action mailed on August 30, 2005.

Petitioner then filed the amendment of October 31, 2005. Petitioner states that the 23 claims of October 31, 2005 were directed to the Figures in the following manner: In the amendment, claim 1 is directed to Figs. 1 and 2; claim 6 is explained in the specification; claim 14 is directed to Fig. 1; claim 16 is directed to Figs. 7 and 8; claim 19 is directed to Fig. 1; claim 20 is explained in the specification; claim 21 is directed to Figs. 7 and 8; claim 22 is directed to Fig. 7; and claim 23 is explained in the specification. The Examiner mailed an Advisory Action stating that the claims would require further consideration. As a result, the Petitioner filed a Request for Continued Examination and that the claims of October 31, 2005 be entered. The Examiner then mailed the Notice of Non-responsive amendment withdrawing all the pending claims by original presentation.

After review of all the claims filed in this application, the claims have been interpreted to align with the embodiments shown in the Figures as follows: The originally filed claims had claims that were generic (claims 1 and 2), claims that were generic to a half bead (claims 3 and 4), claims that were generic to a full bead (claims 7-10), claims that were specific to the embodiment of Figs. 3 and 4 (claim 11), claims that were specific to the embodiment of Figs. 5 and 6 (claim 12) and claims that are specific to the embodiment of Figs 9-11 (claim 5).

The claims presented on June 30, 2005 are interpreted as having claims that are were generic (claims 1, 2, 14-16), claims that were generic to a half bead (claims 3, 4 and 17), claims that were generic to a full bead (claims 8-10), claims specific to the embodiment of Figs. 3 and 4 (claim 11) and claims that were specific to the embodiment of Figs. 5 and 6 (claims 12, 18).

The claims presented in the October 31, 2005 amendment are interpreted as having claims that are specific to the embodiments of Figs. 1, 2, (claim 1), claims that are specific to the embodiment of Fig. 1 (claims 14 and 19), claims that are explained only in the specification (claims 6, 20 and 23), claims specific to the embodiments of Figs. 7 and 8 (claims 16 and 21), claims specific to the embodiment of Fig. 7 (claims 21 and 23), and claims that are specific to the embodiment of Fig. 7 (claim 22).

It is agreed that the Examiner had examined claims that were specific to multiple embodiments before the claims of October 31, 2005. Furthermore, it is noted that there was never a formal restriction requirement made by the Examiner. Without such a formal restriction, withdrawal of claims by original presentation is improper.

Since the Applicant voluntarily amended the claims on March 2, 2006, before the filing of the Petition under 37 CFR 1.144, the relief requested by the petitioner of having; the communication of February 14, 2006 withdrawn, the Office action May 2, 2006 vacated, and an examination of all claims filed October 31, 2005, will not be granted. However, the application will be forwarded to the examiner to make a formal restriction

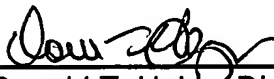
requirement with respect to the amendment of Oct. 2, 2006. The Applicant will thus be given an opportunity to traverse and argue the specifics of the formal restriction requirement, and if desired, further amend the claims consistent with this formal restriction.

Therefore the Petitioner's request that the communication of February 14, 2006 be withdrawn, the Office Action of May 2, 2006 be vacated, and an examination take place on all claims filed October 31, 2005 is **DISMISSED**.

However, the Petitioner's argument that the restriction requirement must be formally presented is agreed with and the implied request thereof is being **GRANTED**.

SUMMARY: The Petition is **GRANTED-IN-PART**.

Any questions regarding this decision should be directed to Patricia Engle at 571-272-6660.



Donald T. Hajec, Director
Technology Center 3600
571-272-5150

SNM/ple : 11/07/06

